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Subject: Application SN 10/045,301

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Memo: Following is Applicant's Reply Brief in the above-referenced patent application.

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Attorney Docket No. 0006-0023

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number: 10/045,301  
In re Application of: Robert S. Bosko  
Date Filed: October 26, 2001  
Title: Systems and Method with Treated Water

Commissioner for Patents  
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P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**REPLY BRIEF**

Applicant hereby presents its Reply Brief, pursuant to 37 C.F.R. § 41.41. This brief is in reply to the Examiner's Answer, which was mailed on August 3, 2006. This replaces Applicant's Reply Brief of August 16, 2005, which was in response to the Examiner's originally filed Answer that was vacated by the Board's decision of November 23, 2005.

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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this Reply Brief is being transmitted, via facsimile transmission, on the date shown below, to: Commissioner for Patents, Mail Stop Appeal Brief – Patents, Official Fax Number (571) 273-8300.

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Dennis Braswell

**A. Introduction**

Applicant files this Reply Brief to address significant errors in the Examiner's Answer. For clarity, Applicant specifically traverses and appeals all of the examiner's conclusions, whether or not specifically addressed herein, as detailed in Applicant's Appeal Brief.

**B. The Written Description Plainly Supports the "Cabinet" Recitations**

In responding to Applicant's arguments relating to the §112 rejection of Claims 1, 6-8, 11-15, and 18-31, the examiner agrees that the written description discusses cabinets, but asks, "Where is supporting disclosure" for the claim language of sharing a cabinet "such that said treated water source is integral with the water-using unit . . ."<sup>1</sup> In effect, the examiner is asking for support for the link between integration and the cabinet.

The support for this link is found in the written description, in the paragraph on Page 6, lines 5-12, of the specification:

"By designing equipment with an integral treated water source, significant advantages are achieved. For example, as will be discussed in detail below, water and energy conservation can be significantly enhanced, for example by using input or drain water to cool the condenser in systems that include vapor compression refrigeration systems. Furthermore, manufacturing and maintenance costs are reduced, because the treated water source is built in as part of the host equipment, thereby eliminating the need for two cabinets, two sets of electronic controls, and other redundant systems. Similarly, installation costs are greatly reduced, as only one piece of equipment needs to be installed."

As provided in this passage, significant advantages are achieved through integration, and the written description goes on to give examples of those advantages. One of those examples is that "manufacturing and maintenance costs are reduced, *because*

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<sup>1</sup> This language is in each of the independent claims 1, 20, and 31.

*the treated water source is built in as part of the host equipment, thereby eliminating the need for two cabinets, two sets of electronic controls, and other redundant systems.”*

The clear meaning of this passage is that with integration, two units share a cabinet. Therefore, it plainly supports the claim language of “sharing at least part of said cabinet such that said treated water source is integral with the water-using unit”, because by sharing the cabinet, the units are integrated. Applicant is at a loss to understand how such clear support can be overlooked, or misunderstood, and requests that the Board require that the §112 rejection be withdrawn.

Furthermore, with respect to Claim 20’s remote unit limitations, the examiner has agreed (on page 10, third full paragraph of section (10)(1) of the Examiner’s Answer) with Applicant’s arguments that remote units have separate cabinets, and thus do not share a cabinet (as recited in the claims). However, the rejection has apparently been maintained, because the examiner stated that “there has to be sufficient disclosure in the specification to support the claim limitation for patentability over the prior arts.” This rejection is contrary to the law. As stated in MPEP § 2163.07(a), “[b]y disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage [in this application, the examiner has agreed that remote units have separate cabinets], a patent application necessarily discloses that function, theory, or advantage, even though it says nothing explicit concerning it. *The application may later be amended to recite the function, theory, or advantage without introducing prohibited new matter. In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F.2d 1376, 178 USPQ 279 (CCPA 1973).” (emphasis added). Therefore, Applicant requests that the Board require that this other §112 rejection be withdrawn.

**C. The Examiner Failed to Address the Fundamental Inconsistency and Error in the Rejection of Claim 20 and its Dependent Claims**

The examiner argues that Boulter shows both a common cabinet, and separate, remote units (Examiner's Answer, page 11), and maintains the rejection of Claim 20 and its dependent claims (under 35 USC §§102 and 103). To make these rejections, the examiner designates Boulter's kiosk as a common cabinet, and then designates various units within the kiosk, such as its ice-maker and ice-dispenser,<sup>2</sup> as being separate units. As pointed out in the Appeal Brief, this rejection overlooks a significant inconsistency in its rationale: If the kiosk *is* a common cabinet, then the units within it cannot be separate units that do not share the common cabinet, as required by Claim 20; and, if the kiosk *is not* a common cabinet, then there can be no integrated water treatment system and water-using unit. Whichever view is taken, the rejection fails.

In an attempt to save the rejection, the examiner has taken the extraordinary position that receiver tanks and compressors, which are located on top of Boulter's kiosk, are the separate units recited by Claim 20. That position is simply untenable.

Claim 20 recites that the separate unit "does not share said cabinet, said separate unit having a second user access area, said separate unit supplied by said treated water source, and wherein said first and second user access areas are not presented as a combined user access area." First of all, the receiver tanks and compressors are not supplied by the treated water source, and thus cannot themselves be the separate units recited by Claim 20. Second, as acknowledged by the examiner, and as provided in Boulter at column 6, lines 29-35, these roof top units are part of the ice-cube maker, which, according to the examiner's logic, *does share* Boulter's common cabinet – its kiosk.<sup>3</sup> Thus, if they are viewed as part of the ice-cube maker, then Boulter shows no separate units that do not

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<sup>2</sup> It is wrong to consider units such as Boulter's ice-dispenser and ice bin as separate units, because they are not supplied by the treated water source, as specifically recited in Claim 20. This language seems to have been ignored in the rejections.

<sup>3</sup> The examiner's reference to Boulter's air cooler is disingenuous, because it is not supplied by the treated water source, and thus cannot be a "separate unit" as recited in Claim 20.

share the kiosk. Once again, the examiner's logic is unsound. If the roof top units are separate from the ice maker, then they are not supplied by the treated water source as required by Claim 20. If they are part of the ice maker, then Boulter shows no separate unit that *does not* share a common cabinet, as required by Claim 20.

***D. Claim 20's Combination of an Integrated Unit and a Remote Unit is Not Obvious***

At page 12 and 13 of the Examiner's Answer, it is asserted that it would be obvious to make common or separate cabinets as recited in Claim 20 and its dependent claims. This conclusion, while perhaps appropriate in other cases, is not at all appropriate here, and betrays a fundamental misunderstanding of the nature of the claimed invention as a whole. Claim 20 is directed to a system that includes (1) a unit that includes an integrated treated water source, and (2) a remote unit *that is supplied* by the treated water source. As stated in the written description, at Page 13, line 22 – Page 14, line 5, and as shown in FIGURE 6:

“With the system 100 shown in FIGURE 6, treated water from the unit 102 can be supplied to the entire system, which may reside, for example, without limitation, at a restaurant or convenience store. Thus, treated water is available to improve quality, at a relatively low cost. For example, with the treated water source 104 included as part of equipment 102, manufacturing, installation, and maintenance costs are significantly reduced. Also, lower maintenance cost result for all the pieces of equipment since they do not need to be cleaned of untreated water deposits, as is required today.”

Thus, the treated water source that is integrated with one unit not only provides water to that unit, but supplies treated water to other, remote units as well. With this description in mind, it is clear that the examiner's stated reasons for why it would be obvious to combine or separate cabinets are simply after-the-fact, hindsight conclusions that are entirely inapplicable to the present invention. The rationale provided by the examiner – weather protection or lock-and-key security – have nothing to do with why the present invention integrates a treated water source with one unit, for supply to other remote

units. Indeed, those considerations would lead one to integrate all units together; not to integrate a treated water source with one unit, and not another – which is what is claimed in Claim 20. The invention of Claim 20 is not in how the integration is accomplished in one unit – rather it is in the combination of one integrated unit and a remote unit supplied by the integrated unit. It seems as though the claim language requiring that the remote unit be supplied by the integrated unit has been ignored.

Similarly, the examiner's citation of the *In re Larson* and *In re Dulberg* cases is inapposite, because the recited invention does not turn on integrating or not integrating, but on *the combination system of one integrated unit and a remote unit supplied by the integrated unit*. The advantages of such a combination distinguish the instant claims from situations where only integration or separation is involved.

It is clear that the examiner has engaged in hindsight reconstruction, casting about for reasons why it would be obvious to combine the elements of Applicant's claims. Even with this effort, however, the only reasons that the examiner could come up with – weather protection or lock-and-key security – are inapposite to the present invention *and would actually lead away from it*, and cannot, therefore, form the basis for a proper rejection.

#### E. "*Cooling Proximity*" is Not Disclosed in Boulter

The examiner failed to respond to Applicant's explanation of why Boulter does not teach or suggest the claimed cooling proximity of Claims 24, 27, and 31. In particular, to persist in the rejection, the examiner had to overlook specific recitations in the claims that distinguish Boulter, which is clearly improper. These claims recite that the treated water source comprises a reservoir, and that the treated water source shares a cabinet with the water-using unit. Boulter's Figure 32 shows no such cabinet sharing. All Boulter shows is a separate ice maker supply tank – not a reservoir integrated with its ice maker.

Moreover, as explained in the Appeal Brief, Boulter shows only reclaiming of harvest overflow water, not cooling due to proximity, as claimed. *See*, Boulter, Col. 8, lines 39-41. Cooling due to proximity involves heat transfer due to the close location of

elements, not heat transfer through the transmission of water from one unit to another. It is important that the present application, at Page 10, lines 7-13, and in Claim 14, specifically distinguishes the reclaiming of unfrozen water and proximity cooling of a reservoir. Simply because the two elements in Boulter are shown in the same drawing Figure does not mean they are in cooling proximity, as specifically described in Applicant's specification. *See*, Page 9, lines 15-20 and Page 13, lines 3-7.

Also, the examiner has used the weather protection, lock-and-key security, and *In re Larson* and *In re Dulberg* rationale in arguing in favor of the rejection of Claims 24, 27, and 31 (page 12-13 of the Examiner's Answer). However, as discussed above in Section D, this rationale does not apply to these claims, and thus does not support a proper rejection.

#### **F. Claim 1 and its Dependent Claims are Not Obvious**

The examiner failed to address *any of* Applicant's arguments with respect to "cooling proximity" made in connection with Claim 1 (see, Appeal Brief, Section 3, page 11), and thus has acquiesced to those arguments. Therefore, Claim 1 and its dependent claims should be allowed.

Moreover, the Examiner's Answer is insufficient to remedy the previous failure to present a *prima facie* case of obviousness. While the examiner does provide a list of benefits to Voznick's flexible container, and states that those advantages would motivate one to combine Voznick and Boulter, no rationale is provided for *why* those benefits would motivate one to combine it with Boulter. And, as explained in the Appeal Brief (Section 3.1), that is precisely what the examiner must do to meet his burden. Having failed at that, the claims should be allowed.

It should also be noted that the case of *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), has been cited by the examiner. That case stands only for the proposition that hindsight analysis is necessarily involved in determining what one of ordinary skill in the art would have been motivated to try at the time of the invention.

However, that case is all too often cited as a smoke screen to obscure the kind of improper hindsight reconstruction engaged in here, which is prohibited by strong Federal Circuit decisions. Neither does that case excuse the examiner from providing the kind of detailed analysis required for proper rejections.

**G. *Credle and Boulter are Not Properly Combinable***

In defense of the obviousness rejection of Claims 26 and 28-30, the Examiner's Answer simply concludes that "it would be obvious to one of ordinary skill in the art to attach a postmix beverage dispenser as taught by Credle to the water-source-supply system of Boulter to have a beverage dispenser system to which clean and refrigerated water is supplied as taught by Boulter." This conclusory rejection again falls short of the requirements for a proper rejection, for the reasons provided in the Appeal Brief at Section 4. Moreover, given that the Appeal Brief pointed out this defect in its Section 4, it is revealing that the examiner has been unable to supply any detailed analysis in support of the rejection. That lack reveals that there is no analysis to support the conclusion.

It is not enough to conclude that it would be obvious to combine a postmix dispenser with Boulter, simply because one possibly *could*. The examiner must show *why* one would have combined a postmix dispenser *not just with Boulter, but with all the elements of Claim 26*. Of course postmix dispensers use clean, refrigerated water. But why from Boulter, why as recited in Claim 26? The examiner has been unable to answer those questions.

Also, as discussed above in Sections C and D, Claim 20 is allowable, and thus, for this additional reason, Claims 26 and 28-30 should be allowed.

**H. *No Rationale Has Been Provided for Rejecting Claims 15 and 18-19***

Claims 15 and 18-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Boulter in view of Voznick and Credle. Applicant pointed out, in Section 5 of the Appeal Brief, that no rationale has been provided in support of the rejection. In defense of that rejection, the examiner now merely cites *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981), for the obviousness test concerning what the combined teachings of the references suggest. While *In re Keller* does stand for this, that conclusion does not alter the strength of Applicant's arguments in the Appeal Brief. The examiner has failed to meet his burden of showing what the combined teachings of the references suggest. Merely citing a case does not make that showing.

**I. *Rejections of Claims 6, 7, 11, and 12***

Claims 6, 7, 11, and 12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Boulter in view of Voznick and U.S. Patent No. 5,536,411 ("Blades"). As Applicant argued in Section 6 of the Appeal Brief, the examiner has failed to provide anything more than a conclusion of obviousness. Only a list of the elements that each reference teaches is provided, and the rejection merely states "[i]t would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of Blades in the teaching of Boulter in view of Voznick for energy recovery as taught by Blades in the 'Boulter in view of Voznick' system." Such a list, which provides no basis for understanding the reasons why the combination was obvious, is a tell-tale sign of improper hindsight reconstruction.

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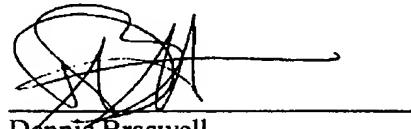
In view of the foregoing, Applicant respectfully requests that the Final Rejection of the Examiner, dated September 16, 2004, be reversed on all grounds, and that all claims be allowed. If there are any questions concerning this Reply Brief, please call Dennis Braswell at the telephone number set forth below.

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Oct 2, 2006

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